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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,018	03/14/2005	Tetsuo Santo	JCLA14660	8744
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J C PATENTS, INC.			CLARK, AMY LYNN	
4 VENTURE, SUITE 250			ART UNIT	PAPER NUMBER
IRVINE, CA 92618			1655	
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			01/11/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/511,018	<b>Applicant(s)</b> SANTO ET AL.	
	<b>Examiner</b> Amy L. Clark	<b>Art Unit</b> 1655	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-16 is/are pending in the application.
- 4a) Of the above claim(s) 13, 14 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-12 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 9-16 are currently pending.

Applicant's election of Specie C, claims 9-12 and 15 in the reply filed on 28 September 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 13, 14 and 16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 28 September 2007.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 9-12 and 15 are currently under examination.**

### ***Claim Objections***

Claims 9-12 and 15 are objected to because of the following informalities:  
Claims 9-12 and 15 are all poorly written and should all be rewritten patterned based upon the following amendment to claim 9 as suggested by the Examiner. Claim 9 should be rewritten in the following manner: "A cream for the treatment of dermatitis characterized in that the volume ratios of respective ingredients are comprising:  
Lightyellow Ssophora Rroot (Sophora flavescntis Ait.), in an amount of 2.7 to 3.3%;

Turmeric (*Curcuma aromatica* Salisb.), in an amount of 1.8 to 2.2%; Magnolia Bark (*Magnolia officinalis* Rehd. Et. Wils.), in an amount of 1.8 to 2.2%; Moutan Bark (*Paeonia suffruticosa* Andr.), in an amount of 1.8 to 2.2%; Isatis Leaf (*Isatis tinctoria* L.), in an amount of 0.9 to 1.1%; Borneo Camphor Tree (*Dryobalanops aromatica* Gaertn. f.), in an amount of 0.9 to 1.1%; Baikal Skullcap (*Scutellaria baicalensis* Georgi.), in an amount of 1.8 to 2.2%; Amur Cork Tree (*Phellodendron amurense* Rupr.), in an amount of 1.8 to 2.2%; Angelica Dahurica Root (*Angelica dahurica* Benth. et Hook.), in an amount of 0.9 to 1.1%; Lemon (*Citrus Limonum*), in an amount of 0 to 3%; Smartweed (*Polygonum cuspidatum* Sieb. et Zucc), in an amount of 0 to 1.1%; Licorice (*Glycyrrhiza uralensis* Fisheh.), in an amount of 0 to 0.55%; Cnidii Rhizoma root (*Ligusticum chuanxiong* Hort), in an amount of 0.45 to 1.1%; Japanese Angelica Root (*Angelica sinensis* (Olive) Diels.), 0 to 0.55%; salicylic acid, in an amount of 0.45 to 0.55%; resorcinol, in an amount of 0.45 to 0.55%; mutton oil, in an amount of 2.7 to 3.3%; alcohol, 2.7 to 3.3%; and white soft paraffin, in an amount of 63 to 78%." All claims should be written in the same manner as claim 9, including italicizing the Latin name of each ingredient. In the case of claim 15, Applicant should amend claim 12 to read: "The cream for the treatment of dermatitis of claim 11, wherein the Lightyellow Sophora Root (*Sophora flavescens* Ait); Turmeric (*Curcuma aromatica* Salisb.); Magnolia Bark (*Magnolia officinalis* Rehd. Et. Wils.), Moutan Bark (*Paeonia suffruticosa* Andr.), in an amount of 1.8 to 2.2%; Isatis Leaf (*Isatis tinctoria* L.)-and the Borneo Camphor Tree (*Dryobalanops aromatica* Gaertn. f.)-serve as are main components of the cream, the dimethyl sulfoxide serves as is an

accelerating agent for permeation, ~~the~~ salicylic acid and ~~the~~ resorcinol ~~serve as~~ are accelerating agents for keratinization, and, wherein the ratios of the main components: accelerating agent for skin permeation : accelerating agents for kemtinization are 53 to 89% : 8 to 38% : 6 to 10%". Please also correct all instances of "dimethylsulfoxide" to read dimethyl sulfoxide. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

Claims 9-12 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The metes and bounds of Claims 9-12 and 15 are rendered uncertain because the amounts of the ingredients are not set forth in terms of either "by weight" or "by volume" amount of the total composition. Therefore, it is unclear if Applicants intend that the ingredients are in relation to each other or in relation to the entire composition and it is, therefore, unclear as to whether these percentages are in terms of percent by weight or percent by volume. The lack of clarity renders the claims indefinite since the resulting claims do not clearly set forth the metes and bounds of the patent protection desired.

### ***Claim Rejections - 35 USC § 103***

Claims 9-12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uehara et al. (N, JP 2000-119156 A, Translation provided herein), in view of Wang

(O, CN 1347717 A, Translation of abstract only), Matsumoto (P, JP 2000-044481 A, Translation provided herein), Kuga (Q, JP 06-256203 A, Translation provided herein), Yamamura et al. (R, JP 2003-292432 A, Translation provided herein), Watanabe et al. (S, JP 06-211713 A, Translation provided herein), Suwa et al. (T, JP 2002-047193 A, Translation provided herein) and Vorhees (A, US Patent Number: 4,034,087 A).

Uehara teaches a topical composition in the form of a lotion, which reads on cream, for preventing skin inflammation (which reads on dermatitis) comprising turmeric (*curcumae rhizoma*, which is synonymous with *Curcuma aromatica*), *Scutellaria baicalensis*, *Sophora flavescens*, cnidium rhizome, Angelica radix, *Phellodendron amurense*, liquorice and lemon (See abstract and paragraph 0010). Uehara further teaches the composition may comprise resorcinol (See paragraph 0008), alcohol (See paragraph 0020), vaseline, which is synonymous with white soft paraffin, lanolin (See paragraph 0023), which is synonymous with mutton oil, and salicylic acid (See paragraph 0030).

Wang teaches a topical medication for treating psoriasis and for diminishing inflammation (which reads on treating dermatitis) in the form of an ointment, comprising Isatis leaf and Radix *Sophorae flavescens* (which is synonymous with *Sophora flavescens*).

Matsumoto teaches a topical composition for suppressing inflammation due to atopic dermatitis comprising *Sophora flavescens*, liquorice, scutellaria root (root of *Scutellaria baicalensis*), Japanese angelica root, moutan bark (See abstract) and salicylic acid (See paragraph 0007).

Kuga teaches an ointment for treating dermatitis comprising root of *Angelica duhurica* and root of *Scutellaria baicalensis* (See abstract).

Yamamura teaches a skin preparation in the form of an ointment, lotion or cream comprising magnolia bark, which is synonymous with *Magnolia officinalis*, cnidium rhizome, which is synonymous with *Ligusticum chuanxiong*, and turmeric for preventing inflammation, which is synonymous with dermatitis (See abstract).

Watanabe teaches a drug for treating atopic dermatitis (See abstract and paragraph 0019), wherein the drug may be in the form of an ointment (See paragraph 0020), comprising borneol obtained from *Dryobalanops aromatica* (See abstract). obtain an oral composition or a composition of a preparation for external use used for the purpose of treatment or prevention of relapse of allergic dermatitis, especially treatment or prophylaxis of atopic dermatitis.

Suwa teaches a composition for external use for treating and preventing allergic dermatitis comprising *Polygonum cuspidatum*.

Vorhees teaches a topical composition, wherein the composition may be in the form of an ointment, lotion or paste, which reads on cream, comprising a skin penetrating adjuvant, such as dimethyl sulfoxide, and lemon oil.

Uehara does not teach that the cream for treatment of dermatitis further comprises isatis leaf, licorice, moutan bark, Japanese Angelica root, root of *Angelica duhurica* *Magnolia officinalis*, cnidium rhizome, *Dryobalanops aromatica*, *Polygonum cuspidatum*, and dimethyl sulfoxide, nor does Uehara teach all of these ingredients in the instantly claimed amounts. However, it would have been obvious to one of ordinary skill

in the art at the time the invention was made to modify the composition taught by Uehara to provide the instantly claimed invention because at the time the invention was made, it was known that each of the instantly claimed ingredients were useful for the same purpose, in that all of the instantly claimed ingredients are effective for treating dermatitis, as clearly taught by Uehara, Wang, Matsumoto, Kuga, Yamamura, Watanabe, Suwa and Vorhees. One would have been motivated to use the claimed ingredients, because the claimed ingredients can be topically applied in the form of a cream and are known to have beneficial properties for the skin, such as treating dermatitis. Furthermore, one of ordinary skill in the art would have reasonable expectation of success in using such a composition for topically treating dermatitis because the beneficial properties of the ingredients are taught by the cited references.

Although Uehara and the other references do not expressly teach that the dimethyl sulfoxide is an accelerating agent for permeation, salicylic acid and resorcinol are accelerating agents for keratinization, that Cniidi Rhizoma and Japanese Angelica Root are accelerating agents and the rest of the composition is the main composition, the claimed functional properties are intrinsic to the preparation taught by the cited references because the ingredients are useful for the same purpose and the route of administration for the delivery of the ingredients taught by the above cited references are one and the same as disclosed in the instantly claimed invention of Applicant. Thus, a cream for treating dermatitis comprising salicylic acid and resorcinol, wherein salicylic acid and resorcinol are accelerating agents for keratinization, Cniidi Rhizoma and Japanese Angelica Root, wherein these ingredients are accelerating agents and



the rest of the composition is the main composition is intrinsic to the compositions taught by the above cited references.

Furthermore, it has been held that combinations of two or more compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is to be used for the very same purpose. In re Susi, 58 CCPA 1074, 1079-80, 440 F.2d 442, 445, 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21, 279 F.2d 274, 276-77, 126 USPQ 186, 188 (1960). As the court explained in Crockett, the idea of combining them flows logically from their having been individually taught in prior art. Therefore, since each of the references teach that the ingredients claimed by Applicant are effective ingredients in compositions for treating dermatitis, it would have been obvious to combine these ingredients with the expectation that such a combination would be effective in skin care compositions. Thus, combining them flows logically from their having been individually taught in prior art.

Moreover, it would have been merely a matter of judicious selection to one of ordinary skill in the art at the time the invention was made to modify the amounts of each ingredients to provide the instantly claimed invention because it would have been well in the purview of one of ordinary skill in the art practicing the invention to pick and choose a concentration of each of the ingredients taught in the above cited references because each of these ingredients were known to have the same functional effect in that all of the ingredients are effective in topical compositions, such as a cream, for treating dermatitis. Thus, the claimed invention is no more than the routine optimization

of a result effect variable.

Based upon the beneficial teachings of the cited references, the skill of one of ordinary skill in the art, and absent evidence to the contrary, there would have been a reasonable expectation of success to result in the claimed invention.

Accordingly, the claimed invention was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, especially in the absence of evidence to the contrary.

### ***Response to Arguments***

#### ***Claim Rejections - 35 USC § 103***

Newly amended claims 9-12 and 15 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Tze (N1\*, WO 02/067960 A1), in view of [http://web.archive.org/web/\\*/http://holistic-online.com/Herbal-Med/Herbs/h358.htm](http://web.archive.org/web/*/http://holistic-online.com/Herbal-Med/Herbs/h358.htm) (U\*), Whittle (B\*), Huang et al. (C\*), Yoshioka et al. (D\*), Noevir (V\*), Nakayama et al. (E\*), Ishikawa et al. (F\*), Huang et al. (G\*), Grollier et al. (H\*) and Liang et al. (I\*).

This rejection is maintained for reasons of record set forth in the paper mailed on 30 November 2006 and repeated below, slightly altered to take into consideration Applicant's amendment filed on 29 May 2007.

Applicant's arguments have been thoroughly considered, but the rejection remains the same for the reasons set forth in the previous Office action and for the reasons set forth below.

Tze teaches a composition comprising herbs, such as *Isatis tinctoria* (which is commonly used to treat psoriasis, as taught by

[http://web.archive.org/web/\\*/http://holistic-online.com/Herbal-Med/Herbs/h358.htm](http://web.archive.org/web/*/http://holistic-online.com/Herbal-Med/Herbs/h358.htm))

and *Sophora flavescens* (See page 8, lines 18, 19, 21-23, 25 and 28 and page 9, lines 25 and 27), as chemopreventive and therapeutic agents (See page 1, lines 5 and 6) in the form of a paste (See page 13, lines 10-13), which may be applied topically.

Whittle teaches a composition for topical administration in the form of a cream for treating skin disorders such as eczema and psoriasis (See Abstract and column 3, lines 63-65) comprising of alcohol extracts of licorice, lightyellow sophora root, moutan bark and Baikal skullcap (See column 3, lines 24-33 and 54-62 and columns 9 and 11).

Whittle further teaches a composition for topical administration comprising of white soft paraffin (See column 7, Example 8).

Huang teaches a composition for treating psoriasis in the form of a topical dosage, such as a cream or soft gel (See abstract) comprising radix angelicae sinensis, which is synonymous with *Angelicae sinensis* (Oliv.) Diels, and *Isatis indigotica*, which is synonymous with *Isatis tinctoria*.

Yoshioka teaches a composition in the form of a microcapsule comprising of mutton oil (See column 13, lines 23 and 34), salicylic acid, glycyrrhiza extract (please note that glycyrrhiza is synonymous with licorice), Japanese angelica root extract and lemon extract (See column 15, lines 35 and 40-56), which may be applied to the skin in the form of a cream (See column 70, Example 48) or in the form of a lotion (See column

66, Example 44). Yoshioka further teaches that each of these components are present in an amount of 0.01 to 99% by weight.

Noevir teaches a skin cleansing cream for preventing rough skin comprising of extracts of turmeric and magnolia bark. Noevir further teaches a skin cleansing cream for preventing rough skin further comprising of extracts of cnidii rhizome (which is synonymous with cnidii rhizome) and Angelica radix (which is synonymous with Japanese Angelica).

Nakayama teaches a skin care composition comprising of glycyrrhiza extract, resorcinol (See page 1, paragraph 0009) and its derivatives in an amount of 0.0001 to 20 w/w% (See page 9, paragraphs 0143-0145), Japanese angelica extract in an amount of 0.001 to 20 w/w % (See page 2, paragraphs 0013 and 0014), salicylic acid in an amount of 0.0001-5 w/w % (See page 2, paragraphs 0015 and 0016), and angelica dahurica root in an amount of 0.001 to 5 w/w % (See page 3, paragraphs 0045 and 0046), which can be applied in the form of a cream (See page 10, paragraph 0155). Please note that Nakayama does not expressly teach that the composition can be used to treat dermatitis, however, if a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (See also MPEP § 2112 - § 2112.02).

Ishikawa teaches a cosmetic moisturizer (See Abstract) for preventing and remedying skin roughness (See page 4, paragraphs 0046 and 0048), which is a symptom of dermatitis, in the form of a cream (See page 7, paragraph 0087) comprising

of salicylic acid in an amount of 0.0001 to 5% by weight (See page 4, paragraph 0045), Amur cork tree, licorice, Cnidii rhizome and lemon all in an amount of 0.000001 to 20% by weight (See page 4, paragraphs 0047 and 0048).

Grollier teaches a cosmetic composition for treating skin (See Abstract) in the form of a cream (See column 6, lines 58-64) comprising of water pepper (*Polygonum hydropiper*) (See column 4, lines 22-23), which is synonymous with smartweed, in an amount of 5 to 30 weight % (See column 4, lines 62-68) and sheep oil (which reads on mutton oil) (See column 5, lines 24-27).

Laing teaches a composition in the form of a cream (See page 3, paragraph 0040) suppository for treating human ailments (See Abstract and page 1 paragraph 0013 continued onto page 2) comprising of *Dryobalanops Aromatica* (which is synonymous with Borneo Camphor tree) and *Angelica Dahurica* in an amount of 1 % to 2% of the total weight of the composition (See page 3, paragraphs 0044 and 0045 and page 1 paragraph 0013 continued onto page 2), which read on the percentages of Borneo Camphor tree and *Angelica Dahurica* as claimed by Applicant. Please note that Laing does not expressly teach that the composition can be used to treat dermatitis, however, if a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (See also MPEP § 2112 - § 2112.02).

The teachings of Tze, [http://web.archive.org/web/\\*/http://holistic-online.com/Herbal-Med/Herbs/h358.htm](http://web.archive.org/web/*/http://holistic-online.com/Herbal-Med/Herbs/h358.htm), Whittle, Huang, Yoshioka, Noevir, Nakayama, Ishikawa, Huang, Grollier and Liang are set forth above. Tze does not

expressly teach a cream for therapy of dermatitis comprising an auxiliary agent, Baikal Skullcap, Amur cork tree, Angelicae Dahuricae root, lemon, licorice, smartweed, cnidii rhizome, Japanese Angelica root, mutton oil, salicylic acid and resorcinol, turmeric, magnolia bark, isatis leaf, and borneo camphor tree, nor does Tze teach the specific amounts of each component in a volume ratio. However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art and one would have been motivated and had a reasonable expectation of success to modify the composition taught by Tze to make a skin care composition for treating dermatitis with a composition comprising of lightyellow sophora root, turmeric, magnolia bark, moutan bark, Isatis leaf, Borneo Camphor tree, Baikal skullcap, Amur cork tree, Angelicae Dahuricae root, lemon, smartweed, licorice, cnidii rhizome, Japanese Angelica Root, salicylic acid, resorcinol, mutton oil, alcohol and white soft paraffin because at the time the invention was made, the beneficial effects of a composition in the form of a paste comprising Lightyellow sophora root and Isatis leaf were known, as clearly taught by Tze, as was that Isatis leaf is used to treat psoriasis, as clearly taught by [http://web.archive.org/web/\\*/http://holistic-online.com/Herbal-Med/Herbs/h358.htm](http://web.archive.org/web/*/http://holistic-online.com/Herbal-Med/Herbs/h358.htm), as were the beneficial effects of a topical composition comprising licorice, lightyellow sophora root, moutan bark, Baikal skullcap and white soft paraffin, as clearly taught by Whittle, as a topical composition comprising of licorice, lightyellow sophora root, moutan bark, Baikal skullcap and white soft paraffin for treating skin disorders was known, as clearly taught by Whittle, as were the beneficial effects of mutton oil, salicylic acid, licorice, Japanese angelica root extract and lemon extract and the combination of

mutton oil, salicylic acid, licorice, Japanese angelica root extract and lemon extract composition to make a cream for application to skin, as clearly taught by Yoshioka, as were the beneficial effects of turmeric, magnolia bark, cnidii rhizome and *Angelica radix* for preventing rough skin, as clearly taught by Noevir, as were the beneficial effects of glycyrrhiza extract, resorcinol, Japanese angelica extract, salicylic acid, and angelica dahurica root and the application of the composition to the skin, as taught by Nakayama, as were the beneficial effects of Amur cork tree, licorice, *Cnidii rhizome*, lemon and salicylic acid and a cosmetic moisturizer for preventing and remedying skin roughness, which is a symptom of dermatitis, comprising a composition of Amur cork tree, licorice, *Cnidii rhizome*, lemon and salicylic acid, as taught by Ishikawa, as were the beneficial effects of isatis leaf for treating psoriasis, which is a type of dermatitis, as clearly taught by Huang, as were the beneficial effects of a composition for treating skin comprising of smartweed and mutton oil, as clearly taught by Grollier, as were the beneficial effects of Borneo Camphor tree and *Angelica Dahurica*, as clearly taught by Laing. It would have also been obvious to one of ordinary skill in the art to adjust the amounts of the extracts of lightyellow sophora root, turmeric, lemon extract, turmeric, magnolia bark, moutan bark, isatis leaf, borneo camphor tree, Baikal skullcap, Amur cork tree, *Angelicae Dahuricae* root, lemon, smartweed, cnidii rhizome, Japanese *Angelica* root, mutton oil, salicylic acid and resorcinol, as taught Whittle, Yoshioka, Noevir, Nakayama, Ishikawa, Huang, Grollier and Liang to provide the instantly claimed invention at the time the invention was made.

As each of the references indicate that the various proportions and amounts of the ingredients used in the claimed composition or the claimed composition/pharmaceutical combinations are result variables, they would have been routinely optimized by one of ordinary skill in the art in practicing the invention disclosed by each of the references.

Moreover, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add any of the claimed ingredients in the making of the claimed composition because it is well known that its *prima facie* obvious to combine two or more ingredients, each of which is taught by the prior art, to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. *In re Susi*, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); *In re Crockett*, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960).

Based upon the beneficial teachings of the cited reference, the skill of one of ordinary skill in the art, and absent evidence to the contrary, there would have been a reasonable expectation of success to result in the claimed invention.

Accordingly, the claimed invention was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, especially in the absence of evidence to the contrary.

In response to Applicants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by



combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, any of the references cited that do not expressly teach the exact intended use claimed by Applicants, these references teach the ingredients claimed by Applicants in amounts that fall within the ranges claimed by Applicants. Therefore, as stated above, irrespective of whether the intended use is the same as that claimed by Applicant, which it should be noted has no patentable weight, these ingredients are taught in the amounts claimed by Applicants, therefore, these compositions intrinsically are capable of performing the functions claimed by Applicants. Furthermore, these ingredients are all known to be useful in skin care compositions that may be administered topically. Therefore, there is sufficient motivation to combine these references.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy L. Clark whose telephone number is (571) 272-1310. The examiner can normally be reached on 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Amy L. Clark  
AU 1655

Amy L. Clark  
December 31, 2007



CHRISTOPHER R. TATE  
PRIMARY EXAMINER